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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Michael J. Dove

Serial No.: 10/053,892

Filed: January 23, 2002

For: **TELESCOPING EXTENSION POLE WITH BUILT-IN TUBE END PROTECTION**

Group Art Unit: 3676

Examiner: Williams, Mark A.

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Please find included:

Appellant's Appeal Brief beginning on page 2 of this correspondence and consisting of 11 pages numbered 2-12; and

Check number 2528 in the amount of $250.00 (the fee for filing a brief in support of an Appeal) is attached herewith.

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Michael J. Dove Date 1/19/05

In re Application of: Michael J. Dove

Serial No. 10/053,392

Filed: January 23, 2002

For: TELESCOPING EXTENSION POLE
WITH BUILT-IN TUBE END PROTECTION

Group Art Unit: 3676

Examiner: Williams, Mark A.

Appeal Brief

Related Appeals and Interferences

This is an appeal from the final rejection of the Examiner dated May 21, 2004. Appellant is not aware of any other related appeals and interferences.

Status of Claims

The application was filed on January 23, 2002, with three (3) claims of which Claim 1 was independent.

All of the claims were rejected on August 15, 2003.

In appellant's response dated February 15, 2004, Claims 1-3 were amended and new Claims 4-8 were added.

In a Final Office Action dated May 21, 2004, the Examiner rejected Claims 1-8. In addition, the Examiner objected to the drawing filed on January 23, 2002, however, replacement drawings were filed with Appellant's response dated February 15, 2004.

Appellant filed a response after final on August 23, 2004. Claims 1-4 were cancelled, Claim 5 was amended, and Claims 9-16 were added.

An Advisory Action dated November 18, 2004 indicated that for purposes of Appeal, the amendments filed on August 23, 2004 would not be entered. However, in a subsequent telephone communication, the Examiner indicated otherwise.

Consequently, as indicated in the Examiner's Advisory Action dated December 22, 2004, the proposed amendments as contain in Appellant's response to the aforementioned Examiner's final rejection will be entered for purposes of this Appeal.

An amendment after the date of filing an Appeal and prior to the date of filing this brief (January 19, 2004) was filed on January 18, 2004. Appellant indicated that the amendments added no new matter, did not raise new issues for consideration, or necessitated a new search. Appellant respectfully requested that amendments, to correct typographical errors regarding connectivity in Claims 5 and 13 that may have been confusing to the reader, be entered for purposes of this Appeal.

Accordingly, Claims 5-16 as contained in Appellant's amendment of January 18, 2004, are the subject of the appeal.

Status of Amendments

An amendment after final rejection filed August 23, 2004 has been entered (see Advisory Action of December 22, 2004). Appellant has proceeded as if the January 18, 2004 amendments will be entered for purposes of the Appeal. If Appellant is incorrect, Appellant respectfully request an opportunity to revise Appellant's Appeal Brief accordingly.

Summary of the Invention

The present invention is directed to an extension pole assembly for a tool such a paint roller or similar apparatus. (paragraph 004, lines 1-2) The extension pole assembly includes a plurality of pole segments configured substantially the same. (paragraph 004, line 7) The pole

segments are capable of being connected together in such a way so that as each successive pole segment is joined together (or as each joined pole segment is removed) an extension pole assembly having a protective end cap is formed without removal of the protective end cap of any other pole segment. (paragraph 008, lines 8-9)

As shown in Figure 1, each pole segment includes a first hollow cylindrical end portion 20 and a second hollow cylindrical end portion 30 having an external diameter 30a smaller than the internal diameter 20a of the first end portion 20. (paragraph 006, lines 3-7) The second end portion 30 preferable includes a protective cap 34 inserted therein. (paragraph 008, lines 4-5)

When desiring to form a pole having a length longer that what currently exists, the second end portion 30, that is the smaller diameter end 30a having a protective cap 34 inserted therein, of the first pole segment is received into a first end portion 20, that is the larger diameter end 20a, of a second pole segment. (paragraph 006, lines 5-8) The first end 20 or larger diameter portion of the first pole segment will typically have a paint roller, scrapper, brush, duster, or some other utility attachment connected. (paragraph 009, lines 1-3) As each pole segment, configured substantially the same, is connected, an extension pole assembly having a protective cap 34 is formed without removal of the protective end cap 34 of the first pole segment. (paragraph 008, lines 8-9)

Alternatively, when desiring to form a pole having a length shorter that what currently exists, removal of each successively added pole segment results in a pole assembly having a protective end cap 34 without removal, replacement, exchange, or substitution of any other protective end cap 34.

Grounds of Rejection

Preliminarily, Appellant notes that the Advisory Action dated December 22, 2004 in which the proposed amendments as contained in Appellant's after final response dated August

23, 2004 were entered for purposes of the Appeal, fails to provide, as indicated in section 7 an "explanation of how the new or amended claims would be rejected. Accordingly, Appellant is unsure exactly what rejections, if any, apply to new Claims 9-16. The Examiner's Advisory Action following Appellant's response after final, rejected then pending Claims 1-8 and indicated that Appellant's proposed amendments (addition of Claims 9-16) would not be entered. That Advisory Action, dated November 18, 2004, did indicate that, "Applicant amendments to the claims are not believed to overcome the art of record." Accordingly, Appellant has proceeded to address the grounds of rejection in regard to Claims 9-16 as if they were rejected for the same reasons as Claims 5-8 as indicated in the Examiner's Final Office Action dated May 21, 2004.

If Appellant is incorrect with regard to the ground for rejection pertaining to Claims 9-16, Appellant respectfully requests an opportunity to amend the Appeal so as to address any ground for rejection Appellant failed to address due to the misunderstanding.

Turning now to the grounds for rejection as contained in the Examiner' Final Office Action dated May 21, 2004:

Claims 5-7, and presumably, 9-16 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,091,790, issued to Schroeder in view of U.S. Patent No. 5,961,387, issued to Parsons, and further evidenced by U.S. Patent No. 4,325,157, issued to Balint el al.

Argument

Of the above-referenced claims, Claims 5, 9, and 13 are independent. Once patentability of those claims is established, all claims depending therefrom are likewise allowable. Accordingly, the remarks set forth below focus primarily on those independent claims.

CLAIM REJECTIONS - 35 U.S.C. §103

Applicant respectfully submits that Schroeder does not disclose a pole assembly having a plurality of pole segments configured substantially the same in which:

each tube segment includes first and second tube portions 20, 30 with the second tube portion 30 having an open end 30a with an inside diameter greater than the outside diameter 20a of a first tube portion 20, and configured for receiving the first tube portion 20 of an existing pole segments (**Claim 5**);

a second end portion 30 (smaller diameter 30a) of a first pole segment having a protective end cap 34 inserted therein being received into a first end portion 20 (larger diameter 20a) of a second pole (**Claim 9**); and

a plurality of pole segments wherein the second end portion 30 (smaller diameter 30a) of one pole segment having a protective end cap 34 inserted therein is received into a first end portion 20 (larger diameter 20a) of subsequently added pole segment (**Claim 13**).

Claim 5

The Schroeder device requires insertion of a smaller end tube 34 into a larger diameter tube 36 in order to lengthen the device. As indicated in Schroeder, ". . . the handle 12 comprises a series of telescopically-end-connected, tubular sections 32, which may be identical in length, and each comprising a male connection at one end and a female connection at the other. Thus, in FIGURE 4, the lower section 32 has a reduced, upper end portion 34, received in the lower end of a section 36. (Column 2, lines 37-42, emphasis added)

In contrast, lengthening Applicant's pole assembly requires that a smaller end 30 of a leading (existing) or first tube be insert into the larger diameter 20a of the tube being added to the assembly. In other words, Schroeder teaches insertion of a smaller diameter pole into a larger

diameter existing pole in order to lengthen the extension assembly. On the other hand, Applicant's invention teaches positioning of a larger diameter pole over the smaller diameter end of an existing pole in order to lengthen the extension assembly.

Schroeder's disclosure primarily focuses on the structure, attachment, and various characteristics of the tool's head 10 which is used to scrape snow and ice from roof tops. There is no teaching, suggestion, or motivation in Schroeder that would lead one skilled in the art to redesign the handle of Schroeder's device. Accordingly, it would not have been obvious to reconfigure the Schroeder device so that it is totally opposite to what is taught by the Schroeder disclosure in order to achieve Appellant's invention. In this regard, it is far too simplistic to suggest that a modification of Schroeder would simply involve reversing pole segment diameters to achieve larger diameter end over smaller diameter end connectivity between tool segments instead of smaller diameter end into larger diameter end connectivity. Not only would Schroeder have to reverse the end diameter of each pole segment, but Schroeder would have to redesign the leaf spring assembly as well in order to operate properly in the new design. This would have left Schroeder with the pin 38 of the leaf spring 40 exposed at the lower handle section 36 similar to the exposed push button 32 on Appellant's lower handle section. In this regard, unlike Appellant, who recognized that the small inconvenience posed by the exposed push button would be far outweighed by the added benefit, as described below, of having a permanently attached protective end cap. Surely, Schroeder did not envision, much less teach, how such a reverse arrangement might have worked.

In view of the simplicity of Appellant's invention it may have been difficult for the Examiner not to use the claimed invention as an instruction manual or "template" to arrive at Appellant's invention. However, failure to provide to necessary suggestion or motivation will

create a presumption that the combination of references selected by the Examiner to support the obviousness rejection were based on impermissible hindsight.

Claims 7, Claim 9, and Claim 13

The argument articulated above applies as well to Schroeder to the extent that reference applies to Claims 9 and 13. The Examiner combines Schroeder with Parsons/Balint et al in order to compensate for Schroeder's lack of protective cap. However, the addition of an end cap to Schroeder would not result in Appellant's invention.

Appellant's pole assembly configuration allows a pole segment to be added to the existing pole assembly without removal of the protective end cap 34 from the smaller end portion 30 of the existing segment as this smaller end portion 30 is inserted into or received into the larger end portion 20 of a tube segment being added to the existing pole assembly. Accordingly, Applicant's invention provides for the formation of an extension pole assembly (extending by the addition of a pole segment) having a protective end cap 34 formed therein without the addition or removal of the protective end cap from any other pole segment. (Claims 7, 9, and 13).

Likewise, shortening of the pole assembly by removal of a pole segment exposes the smaller end portion 30 having a protective cap 34 already inserted therein.

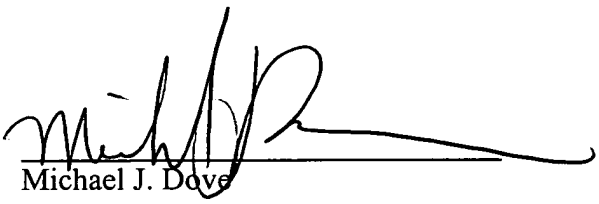
In contrast to Applicant's invention, the Schroeder configuration would require the removal of any protective end cap deemed applicable from Parson/Balint et al from the existing pole assembly's larger diameter end 36 before the smaller end 34 of a pole segment to be added could be inserted to the larger end 36 portion to lengthen the pole assembly.

In this regard, Applicant's invention is a significant departure from the prior art. As each successive pole segment is joined together an extension pole assembly having a protective end is formed without removal of the protective end cap of any other pole segment. Consequently, the

extension pole assembly will always have a protective end cap, removal of the end cap from one pole segment and the insertion of the same end cap into another pole segment is negated, and the possibility of losing end caps or damage to the surrounding environment by an unprotected end of a pole segment is negligible. Simply adding an end cap to Schroeder does not result in Applicant's invention.

In view of the remarks set forth above, Appellant respectfully contends that each claim is patentable. Therefore, reversal of all rejections is courteously solicited.

Respectfully submitted,



Dated: January 19, 2005

Michael J. Dove

Claims Appendix

5. An extension pole arrangement comprising at least one pole segment, each pole segment being substantially identical and comprising:

first and second tube portions, said first portion of a given diameter and extending longitudinally from said second tube portion and terminating with an open end;

said second tube portion having an open end with an inside diameter greater than the outside diameter of said first tube portion, and configured for receiving the first tube portion of an existing pole segment;

said first tube portion including a locking mechanism configured for coacting mating engagement with an aperture in said second tube portion for receiving said locking mechanism; and

whereby said substantially identical pole segments are conjoinable.

6. The extension pole arrangement of Claim 5, wherein said second tube portion is of substantially reduced length comparable to said first tube portion.

7. The extension pole arrangement of Claim 5, wherein the open end of said first tube portion includes protective means mounted thereto.

8. The extension pole arrangement of Claim 7, wherein said protective means is a resilient insert compressibly mounted into the open end of said first tube and protruding outward beyond said open end.

9. An extension pole assembly, comprising:

a first pole segment including:

a first hollow cylindrical end portion; and

a second hollow cylindrical end portion having an external diameter smaller than the internal diameter of the first end portion, and having a protective cap inserted therein;

wherein the second end portion of the first pole segment is received into a first end portion of a second pole segment, the second pole segment configured substantially the same as the first pole segment so that an extension pole assembly having a protective cap is formed without removal of the protective end cap of the first pole segment.

10. The extension pole assembly of Claim 9, wherein the second end portion of the first pole segment and the first end portion of the second pole segment are removably connected by a locking mechanism positioned therebetween.

11. The extension pole assembly of Claim 10, wherein the locking mechanism comprises an aperture positioned on the first end portion of the second pole segment for receiving a spring mounted push button positioned on the second end of the first pole segment.

12. The extension pole assembly of Claim 9, wherein the protective cap protrudes beyond the end of the second end portion and is held in place by compression.

13. An extension pole assembly, comprising:

a plurality of pole segments configured substantially the same and capable of being joined together, each pole segment having a first hollow end portion; and

a second hollow end portion having an external diameter smaller than the internal diameter of the first end portion, and having a protective cap inserted therein;

wherein the second end portion of one pole segment is received into a first end portion of a subsequently added pole segment so that as each successive pole segment is joined together an extension pole assembly having a protective end cap is formed without removal of the protective end cap of any other pole segment.

14. The extension pole assembly of Claim 13, wherein the second end portion of one pole segment and the first end portion of a different pole segment are removably connected by a locking mechanism positioned therebetween.

15. The extension pole assembly of Claim 14, wherein the locking mechanism comprises an aperture positioned on the first end portion of one pole segment for receiving a spring mounted push button positioned on the second end of a different pole segment.

16. The extension pole assembly of Claim 13, wherein the protective cap protrudes beyond the end of the second end portion and is held in place by compression.